

REMARKS

1. Amendment

Claims 23 and 24 are pending in this application. Claims 1-22 were canceled in the amendments previously filed. Claim 24 is amended to remove certain cancers in order to expedite the allowance of the application. Accordingly, no new matter has been added by the amendment, and the entry is respectfully requested.

Applicants reserve the right to file one or more divisional, continuation, or continuation-in-part applications directed to the subject matter recited by canceled or non-elected claims, as well as any other subject matter disclosed in the application that is not encompassed by the pending claims.

2. Rejections Under 35 U.S.C. § 112, first paragraph Should be Withdrawn

Claim 23 is allowed. However, claim 24 is rejected under 35 U.S.C. § 112, first paragraph as allegedly lacking enablement, on the ground that the compounds disclosed in the specification have no pharmacological data for treatments of all the cancer types recited in the claim. (Pages 2-3 of the Office Action). The Examiner suggests that the claim be limited to the specific cancers enabled in the specification. Applicants respectfully traverse this rejection, as discussed below.

The instant invention is directed to methods of controlling wound healing or treating cancer using the claimed compound. The specification sufficiently describes the methods. However, in order to expedite the prosecution of this application and without conceding to the validity of the rejection, Applicants have amended claim 24 to remain solid tumors, and to remove blood-borne tumor, hemangioma, tumor of blood vessel, leukemia and cancer of the bone marrow. Therefore, this amendment renders the pending rejections moot. Applicants respectfully request reconsideration and withdrawal of the rejections in view of the amendment and following remarks.

The application describes that the present invention provides methods for the treatment of cancer, more particularly for the treatment of solid and blood-borne tumors. (Paragraphs [0056]-[0059]). Paragraph [0029] of the specification describes a number of different types of solid tumors and blood-borne tumors. Solid tumors include but are not

limited to melanoma, rhabdomyosarcomas, retinoblastoma, Ewing's sarcoma, neuroblastoma, and osteosarcoma. Blood-borne tumors include such as leukemias. (Paragraph [0029]).

Specifically, Examples 1-6 (paragraphs [0110]-[0121], Examples 10 (paragraphs [0129]-[0130]) and Examples 14-15 (paragraphs [0138]-[0151]) discloses tests for treatments of solid tumors. Figures 4-9 and 12-13 indicate the test results. (Paragraphs [0075]-[0080] and [0083]-[0084]). These disclosures of the present application are sufficient for one skilled in the art to recognize that one could treat solid tumors according to the method described in the specification.

Paragraph [0092] also discloses that the studies with the claimed compound indicate that it is a potent inhibitor of angiogenesis and that it is useful for the treatments of specific types of cancers including, but not limited to, prostate cancer, breast cancer, cervical cancer, uterine cancer, ovarian cancer, gliomas, hemangiomas, Kaposi's sarcoma, pancreatic cancer, retinoblastomas, melanomas, bladder cancer, rhabdomyosarcomas, retinoblastomas, Ewing's sarcoma, neuroblastomas, osteosarcoma, leukemia, and various acute and chronic neoplastic diseases of the bone marrow. Accordingly, a person skilled in the art can make and use the methods for treating the recited tumors without any undue experiment.

Further supports for the specific cancers recited in the amended claim 24 can be found, for example, in paragraph 14 (cancer of the eye), paragraph 18 (carcinoma), paragraph 23 (retinoblastoma), paragraph 24 (ovarian cancer), paragraph 25 (breast cancer or prostate cancer), paragraph 26 (melanoma), paragraph 27 (bladder cancer), or paragraph 31 (multiple small angioma or tumor of lymph vessel).

The first paragraph of section 112 only requires objective enablement that the scope of a claim is reasonably correlated to the scope of enablement provided by the specification. *See, e.g., In re Wright*, 999 F.2d 1557, 1561 (Fed. Cir. 1993) (quoting *In re Marzocchi*, 439 F.2d 220, 223 (C.C.P.A. 1971)). In view of the disclosures of the present application, a person of ordinary skill in the art would understand which cancer can be treated by the claimed invention. Thus, the disclosures of the application are sufficient for a person skilled in the art to treat the recited cancers without any undue experiment.

For the above reasons, Applicants respectfully request that the enablement rejection under 35 U.S.C. § 112, first paragraph be withdrawn.

Conclusion


In view of the foregoing, Applicants believe that the claims as amended overcome rejections under 35 U.S.C. §112, and therefore are in condition for allowance.

Reconsideration, entry of the above amendments, and allowance are respectfully requested.

Should the Examiner not agree that all claims are allowable, a personal or telephonic interview is respectfully requested to discuss any remaining issues and to accelerate the allowance of the above-identified application.

Respectfully submitted,

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Yeabsil Moon (Reg. No. 52,042)
JONES DAY
222 East 41st Street
New York, NY 10017
Tel. (212) 326-3778

For: Anthony M. Insogna (Reg. No. 35,203)
JONES DAY
12750 High Bluff Drive - Suite 300
San Diego, CA 92130
Tel. (858) 314-1200